

Title : Large-Scale, Fault-Tolerant Audio Conferencing In a Purely Packet-Switched Network

Inventors : Warren E. Baxley et al.

Serial No : 10/697,810

Docket : 199-0248US-C

Customer : 29855

Examiner : Redentor M. Pasia

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This is a Pre-Appeal Brief Request for Review and is being filed concurrently with a Notice of Appeal. Reconsideration of pending claims 3-5, 7-10, 12-15 and 40 in the above-identified application is respectfully requested based on the following remarks.

Assignee provides comments regarding the Examiner's response to arguments in the Advisory Action mailed 28 September 2010 and then re-iterates previous arguments in summary with reference to Response to Final Office action filed 07 September 2010. These arguments clearly explain how the Examiner's reliance on Rosenberg is improper and why Rosenberg's "proxy server" cannot be reasonably or logically relied upon to disclose all elements recited for the claimed multipoint control unit (MCU).

1. Comments to Examiner's Response to Previous Arguments in Advisory Action

In response to previous arguments, the Examiner asserts three points. Firstly, the Examiner asserts that claim 40 does not require an MCU to support audio conferences between *three or more endpoints*. However, claim 40 clearly recites "an already active audio conference" and "adding the additional endpoint to the audio conference." Clearly, an already active audio conference has at least two participants and *adding an additional participant* certainly makes at least three. Therefore, the Examiner has incorrectly rebutted Assignee's arguments with respect to this point.

Secondly, the Examiner asserts “it is explicitly shown ... that the use of INVITE messages/requests, in part, manages or prepares calls.” Advisory Action dated 28 September 2010 at p. 3 citing to Rosenberg at col. 3, lines 45-58. However, the management or preparation of calls is wholly different from the managing of an audio conference between three or more participants. As anyone of skill in the art is aware, a MCU performs functions above and beyond managing or preparing calls when performing the claimed function of managing an audio conference.

Thirdly, Assignee believed the Examiner had relied heavily on Rosenberg at col. 15-16 when forming his rejections. In the Advisory Action the Examiner has tried to “correct the Applicant in this notion” and explicitly states he has “relied heavily on Figures 3-4 and its corresponding description in col. 6.” Advisory Action dated 28 September 2010 at p. 4. In reply, Assignee thanks the Examiner for clarifying his rejections and explains that it is completely illogical for the Examiner to rely heavily on Figures 3-4 and its corresponding description because this portion of Rosenberg is in no way directed to an audio conference. Rosenberg at col. 6 is expressly dedicated to explaining an example of a *single user* calling another *single user*. “According to the illustrated example, user cz (110) wants to communicate with user henning (210).” Rosenberg at col. 6 lines 6-7.

Additionally, the Examiner asserts that “[h]aving a ‘new’ INVITE request denotes another call being placed by proxy server.” Advisory Action dated 28 September 2010 at p. 5. With this assertion the Examiner makes clear that his rejection cannot be sustained because the “new” invite request simply does not denote another call. The “new” invite request exemplifies the proxy server performing its standard function (as described in Rosenberg). Rosenberg discloses, “[i]n general, a proxy server receives a request (such as an INVITE message) and then *forwards* the request towards (i.e., not necessarily to) the current location of the callee.” Rosenberg at col. 5 lines 56-58 (emphasis added). The “new” invite request is simply a translated invite request being *forwarded* to server hgs@play because that is where the location server 230 resolved the location of user henning and returned that information to the proxy server. See Rosenberg at col. 6. lines 14-24. As explained above, Rosenberg at col. 5-6 is expressly directed to a *two party* call and the only portion of Rosenberg directed to multiparty conferencing is at col. 15-16. Because Rosenberg at col. 5-6 is directed to two party calling that portion of Rosenberg cannot be reasonably relied on (or heavily relied on) to support an

anticipation rejection of claim 40 which is expressly directed to a conference of at least 3 or more participants.

The Panel is reminded “[t]he identical invention must be shown *in as complete detail* as is contained in the ... claim.” M.P.E.P. § 2131 quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Furthermore, “[t]he elements *must be arranged* as required by the claim...” M.P.E.P. § 2131 quoting *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990) (emphasis added). Finally, “USPTO personnel may not dissect a claimed invention into discrete elements in isolation. Instead, the *claim as a whole* must be considered.” M.P.E.P. § 2106 II (C) (emphasis added). Because the Examiner’s reliance on Rosenberg’s proxy server cannot properly disclose the claimed MCU, the Examiner has failed to present a legitimate *prima facie* case of anticipation (regarding claim 40 when interpreted as a whole) as required by law and USPTO guidelines. Therefore, Assignee respectfully requests the Panel withdraw this rejection.

2. Section 102(b) Rejections

The Examiner has rejected independent claim 40 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent 6,937,597 to Rosenberg et al. (“Rosenberg”). Final Office Action dated 07 July 2010 at p. 4. Assignee directs the Panel to Assignee’s Summary of Rosenberg in Response filed 07 September 2010 at pp. 10-12.

The Examiner’s assertion that Rosenberg’s “proxy server” anticipates the claimed “multipoint control unit” fails for at least the following reasons. The Examiner “notes that the claim limitation ‘multipoint control unit’ is rejected based on the presented functions performed by the claimed multipoint control unit. Details of the functions at least include ‘placing an outbound point to point call from the multipoint control unit to the additional endpoint’ as claimed.” Final Office Action dated 07 July 2010 at p. 2. However, the Examiner appears to fail to properly interpret the claim “as a whole” because, as recited in claim 40, “multipoint control unit [is] *managing* the audio conference.” It is not reasonable to assert Rosenberg’s “proxy server” manages the audio conference. Rosenberg expressly states “a proxy server receives a request (such as an Invite message) and then forwards the request towards (i.e., not necessarily to) the current location of the callee.” Rosenberg at col. 5 lines 56-58. In other words, Rosenberg’s proxy server is used to *determine locations* and not manage audio conferences. Even if one

were to accept the Examiner's interpretation that Rosenberg's "proxy server" actually places an outbound call, the Examiner's assertion that Rosenberg's "proxy server" can anticipate the claimed "multipoint control unit" fails when claim 40 is properly interpreted as a whole. For at least this reason, this is clearly not a sustainable rejection, Rosenberg does not disclose anything *arranged* as in independent claim 40 nor does Rosenberg disclose the identical invention in *complete detail* as required by law and USPTO examining guidelines. If necessary, please see Assignee's further Remarks in Response filed 07 September 2010 at pp. 12-14.

3. Section 103(a) Rejections

The Examiner has rejected independent claim 7 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent 5,995,608 to Detample, Jr. et al. ("Detample") in view of Rosenberg. Final Office Action dated 07 July 2010 at p. 6. Additionally, the Examiner has rejected dependent claims 3-5, 8-10 and 12-15 as allegedly being obvious over Detample in view of Rosenberg and various other secondary references.

Regarding independent claim 7, the Examiner again relies on Rosenberg to show "initiating an outbound call request from said multipoint control unit" and equates Rosenberg's proxy server with the claimed multipoint control unit. However, as shown above with respect to independent claim 40, Rosenberg in no way discloses initiating an outbound call request from a multipoint control unit which is also managing the audio conference. Rosenberg's proxy server cannot be equated with a multipoint control unit and even if one were to assume Rosenberg's proxy server could be equated to a multipoint control unit (which it cannot) it is not Rosenberg's proxy server that *both manages* the audio conference and *initiates an outbound call* because Rosenberg's proxy server functions to locate "callees" (*i.e.*, addresses that have been called) and in the specific bridged example (described in Rosenberg at col. 15-16), the proxy server is attempting to locate a callee that has *already been called* (details explained in Assignee's further Remarks in Response filed 07 September 2010 at pp. 12-14). For at least these reasons, the Examiner's reliance on Rosenberg is inaccurate. Detample, either alone or in combination with Rosenberg, does not disclose each and every element of independent claim 7. Accordingly, the Examiner has failed to present a legitimate *prima facie* case of obviousness as required by law and established Patent Office Procedure. Therefore, Assignee respectfully requests the Panel

withdraw the rejection of independent claim 7 and all claims 3-5, 8-10 and 12-15 which depend from claim 7.

C. Conclusion

Assignee submits, based on the above comments and referenced previously filed Remarks; the Examiner has failed to establish a legitimate *prima facie* case of either anticipation or obviousness as required by law and established Patent Office Procedure. Accordingly, Assignee requests the Panel withdraw the Examiner's rejections and allow all pending claims to issue.

Respectfully submitted,

/William M. Hubbard/

William M. Hubbard, J.D.
Reg. No. 58,935

Wong, Cabello, Lutsch, Rutherford & Brecculeri, L.L.P.
Customer No. 61947 Voice: 832-446-2445
20333 SH 249, Suite 600 Facsimile: 832-446-2424
Houston, Texas 77070

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 199-0248USC									
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on (electronically filed) 2010-10-07 Signature <u>/Kaylen Gonzalez/</u> Typed or printed name <u>Kaylen Gonzalez</u>	Application Number 10/697,810		Filed 2003-10-30								
	First Named Inventor Warren E. Baxley, et al.										
	Art Unit 2474		Examiner Redentor M Pasia								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding: 5px;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top; padding: 5px;"><u>/William Hubbard/</u> Signature</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top; padding: 5px;"><u>William Hubbard/</u> Typed or printed name</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>58935</u></td><td style="vertical-align: top; padding: 5px;"><u>832-446-2400</u> Telephone number</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top; padding: 5px;"><u>October 7, 2010</u> Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	<u>/William Hubbard/</u> Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>William Hubbard/</u> Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>58935</u>	<u>832-446-2400</u> Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>October 7, 2010</u> Date
<input type="checkbox"/> applicant/inventor.	<u>/William Hubbard/</u> Signature										
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>William Hubbard/</u> Typed or printed name										
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>58935</u>	<u>832-446-2400</u> Telephone number										
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>October 7, 2010</u> Date										
<input type="checkbox"/> *Total of _____ forms are submitted.											

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.